

REMARKS

This paper is responsive to the Office Action mailed March 13, 2009. Claims 1-23, 25 and 26 are currently pending and stand rejected. No claims have been amended but a listing of the claims is provided for the convenience of the Examiner. Reconsideration of the claims in view of the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2007/0005762 to *Knox* in view of U.S. Patent No. 5,878,230 issued to *Weber* in view of U.S. Patent Publication No. 2004/0172537 to *Baus*. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Knox*, *Weber*, and *Baus* in view of U.S. Patent Publication No. 2004/0006598 to *Bargagli Damm*. Applicants respectfully traverse the rejection and submit that the cited references do not disclose all of the features of the claims.

Claim 1 requires "sending an initial e-mail message from said internal e-mail facility," "receiving at said e-mail facility a first reply e-mail message," and "sending from said internal e-mail facility a modified version of said first reply e-mail message" all to be performed by the same device, i.e., the internal e-mail facility of the web-based business information system.

The Office Action states that the system disclosed by *Knox* includes a mail server that sends, receives and forwards email. (See Office Action page 3). However, Applicants respectfully disagree that *Knox* discloses "sending an initial e-mail message from said internal e-mail facility," "receiving at said e-mail facility a first reply e-mail message," and "sending from said internal e-mail facility a modified version of said first reply e-mail message," as recited in claim 1.

Knox discloses an email client 20 that sends an email to its associated mail server 22. Rather than sending the email directly to the recipient, the email client's mail server 22 routes the outgoing email to a mail enhancement server 12 that is part of an external system 10. The mail enhancement server 12 edits the outgoing email to contain a tracking code that uniquely identifies the outgoing email. The mail enhancement server 12 then sends the e-mail

message to a mail client 26 via a recipient mail server 24. (See *Knox* paragraphs [0015]-[0017], [0026] and [0029].) However, *Knox* is different from claim 1 because the email client 20, the mail server 22, the mail enhancement server 12 and the recipient mail server 24 do not receive any reply e-mail messages nor do they send any modified versions of reply e-mail messages.

Weber discloses a device which, after receiving an e-mail message from an original sender, can be configured to either (a) reply to the original sender or (b) reply to a third party. (See *Weber* col. 5, lines 4-22). *Weber* fails to disclose sending an initial e-mail message. Moreover, *Weber* does not disclose receiving replies to any of its own e-mail messages, and thus does not disclose "receiving at said e-mail facility a first reply e-mail message."

Baus discloses tracking and authenticating items through a web site. (See *Baus* abstract) However, *Baus* does not disclose sending an initial e-mail message, receiving a reply e-mail message, and sending a modified version of the reply e-mail message.

Accordingly, Applicants respectfully submit that the relied upon references, *Knox*, *Weber*, and *Baus*, fail to teach or suggest "sending an initial e-mail message from said internal e-mail facility, " "receiving at said e-mail facility a first reply e-mail message," and "sending from said internal e-mail facility a modified version of said first reply e-mail message" being performed by the same device for the aforementioned reasons.

Moreover, with respect to amended claim 1, Applicants respectfully submit that the relied upon references, either alone or in combination, fail to teach or suggest at least one additional aspect: "sending an initial e-mail message from said internal e-mail facility ... wherein a local part of said REPLY-TO field of said initial e-mail message comprises a tracking string ...; receiving at said internal e-mail facility a first reply message ... having a TO field including said tracking string; and sending from said internal e-mail facility a modified version of said first reply e-mail message ... wherein a local part of said REPLY-TO field [of said modified version of said first reply e-mail message] comprises a first modified version of said tracking string."

Amended claim 1 requires the same device to send a tracking string to an external contact, receive the tracking string from the external contact, and send a modified version of the tracking string to a native e-mail address of the end user. None of the relied upon references disclose this combination of features. For example, although *Baus* discloses, *inter alia*, allowing

modification of tracking data if a code is determined to be authentic, according to Applicants' best understanding, the tracking data is not modified by an e-mail server nor is the modified tracking data sent to a device.

Although *Knox* discloses a mail server 24 receiving a tracking code from a mail server 12 and forwarding the tracking code to a mail client 26, notably, a modified tracking code is not forwarded to the mail client 26. Indeed, according to Applicants' best understanding, if the mail server 24 were to forward a modified tracking code to the mail client 26, *Knox's* device would fail to operate as intended since the logging server 14, which stores the identity of the email recipient and associated tracking code (*Knox*; paragraph [0026]), would no longer be able to identify the email recipient as the logging server 14 would receive, from the mail client 26, a modified tracking code rather than the stored associated tracking code.

Accordingly, Applicants respectfully submit that neither *Knox*, *Weber*, or *Baus*, alone or in combination with one another, disclose all of the features recited in independent claim 1. Specifically, *Knox*, *Weber*, and *Baus* do not disclose "sending an initial e-mail message from said internal e-mail facility ... wherein a local part of said REPLY-TO field of said initial e-mail message comprises a tracking string ...; receiving at said internal e-mail facility a first reply message ... having a TO field including said tracking string; and sending from said internal e-mail facility a modified version of said first reply e-mail message ... wherein a local part of said REPLY-TO field [of said modified version of said first reply e-mail message] comprises a first modified version of said tracking string." For at least these reasons, claim 1 is allowable over the relied upon references.

Independent claims 15 and 20 recite features that are similar to the features recited in amended claim 1. As discussed above with reference to claim 1, the relied upon references do not teach or suggest these features. Thus, claims 15 and 20 are also allowable over the relied upon references for at least the same reasons as claim 1, as well as on their own merits.

Claims 2-14 are dependent on claim 1, claims 16-19 are dependent on claim 15, and claims 21-23, 25, and 26 are dependent on claim 20. As discussed above, claims 1, 15, and 20 are allowable over the cited art. Thus, claims 2-14, 16-19, 21-23, 25, and 26 are also

patentable for the reasons discussed above with respect to claims 1, 15, and 20, as well as on their own merits.

In view of the foregoing, withdrawal of the rejection of claims 1-23, 25, and 26 under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

/John J. Farrell/

John J. Farrell
Reg. No. 57,291

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 206-467-9600
Fax: 415-576-0300
JJF:kjp
62047901 v1